RK

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK J. PELLEGRINO and ROBERT W. FLETCHER

Appeal No. 2001-0957
Application No. 08/581,992

ON BRIEF

Before THOMAS, KRASS and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-19, all of the pending claims.

The invention is directed to a computer-implemented method for determining risk associated with licensing or enforcing intellectual property, including the determination of a probability of success factor for undertaking a lawsuit of enforcement.

Representative independent claim 1 is reproduced as follows:

1. A process for evaluating the strength of a specific intellectual property for purposes of commercializing it comprising the steps of:

a) interacting with a computer;

b) entering data from one or more sources including from a completed set of pre-selected tasks and from a questionnaire completed by the owner of the intellectual property, into said computer, said computer having been pre-programmed such that said data is organized by one or more predetermined risk factors grouped into categories;

c) evaluating the data by comparing each risk factor and each category to a preset standard;

d) computing a score by transforming said data into a composite score which represents a relative degree of strength associated with any undertaking to commercialize said intellectual property.

No references are relied on.

Claims 1-19 stand rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter in that they are directed to an "abstract idea."

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

The examiner contends that the instant claims are directed to an abstract idea and do not provide a practical application in

the technological arts because there is no manipulation of data nor is there any transformation of data from one state to another being performed by determining the risk associated with licensing or enforcing intellectual property.

We disagree.

In State Street Bank & Trust Co. v. Signature Financial Group Inc., 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), the court indicated that the focus of a statutory subject analysis should be "on the essential characteristics of the subject matter, in particular, its practical utility." State Street, 149 F.3d at 1375, 47 USPQ2d at 1602. Note also the reinforcement of these principles in AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

When we focus on the instant claimed subject matter, we find that the claims are directed to a very practical business application of determining whether a specific intellectual property has enough potential to attempt commercialization or an enforcement lawsuit. The method of the instant claims is a computer-implemented method wherein a programmable computer is used to organize categories, evaluate data and transform the data into a score representative of a relative degree of strength associated with a lawsuit or commercialization; then using that

score to determine probability of success in undertaking the lawsuit or commercialization.

Certainly, the business nature of the claims is of no moment in determining statutory subject matter since State Street put to rest any notion that methods relating to business practices were, somehow, different from other processes and nonstatutory by their very nature.

Since the instant claims employ a programmed computer to calculate a "score" for determining a relative degree of strength associated with undertaking to commercialize intellectual property or for determining a probable success factor for undertaking a lawsuit, we cannot say that any mathematical algorithm described by the instant claims is merely an abstract idea constituting disembodied concepts or truths that are not useful. The calculation of a score for determining probability of success in a lawsuit or for determining the relative strength of undertaking commercialization of an intellectual property is clearly a tangible, useful and practical result which is attained by the instant claimed invention.

Accordingly, the examiner's decision rejecting claims 1-19 under 35 U.S.C. 101 is reversed.

REVERSED

JAMES D. THOMAS)
Administrative Patent Judge)
)
)
)
)
ERROL A. KRASS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
)
HOWARD B. BLANKENSHIP)
Administrative Patent Judge)

EK/RWK

Appeal No. 2001-0957
Application No. 08/581,992

ROBERT W. FLETCHER
10503 TIMBERWOOD CIRCLE
SUITE 220
LOUISVILLE, KY 40223